The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.
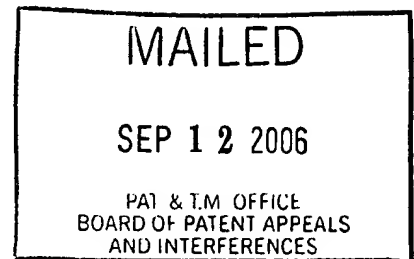
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

<u>Ex parte</u> SHLOMI HARIF

Appeal No. 2006-2193
Application No. 09/751,823

ON BRIEF

Before THOMAS, HAIRSTON, and MACDONALD, <u>Administrative Patent Judges</u>.

THOMAS, <u>Administrative Patent Judge</u>.

<u>DECISION ON APPEAL</u>

Appellant has appealed to the Board from the examiner's final rejection of claims 1 through 3 and 5 through 26, appellant having canceled claim 4.

Representative independent claim 1 is reproduced below:

1. A system for identifying and binding a process, said system comprising a network server adapted to receive a payload from a network client over a network, wherein the payload comprises a request for process execution associated with a task, and wherein the server is further adapted to evaluate the payload, create an agent from the payload, and forward the agent to a network host, unknown to and dissimilar from the network client, for process execution associated with the agent.

The following references are relied on by the examiner:

Kraft et al. (Kraft)	6,112,225	Aug. 29, 2000
May	6,421,653	Jul. 16, 2002
		(Filed Oct. 12, 1998)
Ellis	6,732,141	May 4, 2004
		(Filed Nov. 26, 1997)

Claims 1 through 3 and 5 through 26 stand rejected under 35 U.S.C. § 103. As evidence of obviousness as to claims 1 through 3, 5 through 12, 17, 25 and 26, the examiner relies upon Kraft in view of May, with the addition of Ellis as to claims 13 through 16 and 18 through 24.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief (no reply brief has been filed) for appellant's positions, and to the answer for the examiner's positions.

OPINION

For the reasons set forth by the examiner in the answer, as amplified

and emphasized here, we sustain the rejection of all claims on appeal under

35 U.S.C. § 103.

In the first stated rejection, appellant presents arguments as to each

independent claim 1, 12, 17, 25 and 26 collectively. Independent claims 1,

12 and 17 require that the host be unknown to and dissimilar from the

network client. On the other hand, independent claim 12, which perhaps

appears to be the broadest claim on appeal, does not require that the server

create an agent as in independent claim 1, nor does it require that the

payload from a client relate to a task. The client merely requests a process

execution rather than to request a process execution associated with a task as

in claim 1. As to independent claim 17, this claim does require the creation

of an agent from the payload but there is no task associated with the process

execution from the client. In contrast to that which is extensively argued in

the brief, independent claims 1, 12 and 17 do not explicitly recite the

anonymity such as is recited in independent claims 25 and 26 on appeal.

These two claims require that the client and the network host maintain

anonymity from each other. Because of this, these two claims do not require

that the client and host be dissimilar from each other as set forth in

independent claims 1, 12 and 17 on appeal. Claim 25 recites that the

payload be associated with the task, whereas claim 26 does not recite this

feature. On the one hand, while claim 26 recites the use of the agent, there is

only a broadly recited process in independent claim 25. Therefore, many of

the arguments presented by appellant in the brief are not coextensive with

the actual features recited in the claims on appeal, thus in effect buttressing

the examiner's positions of unpatentability.

With respect to May, we agree with the examiner's views expressed

as to this reference beginning with the background discussion at columns 1

through 4 relating to the extensive prior art discussion there relating to the

need for anonymity in financial transactions or brokerage systems conducted

in an electronic environment. In fact, column 5, lines 20 through 47 address

prior art deficiencies in the major objects of the invention focusing on

maintaining anonymous financial transactions between parties up to a certain point in the transactions between them. Note as well the discussion at column 9, lines 17 through 24; the paragraph bridging columns 12 and 13; the discussion in the paragraph bridging columns 38 and 39; column 42, lines 20 through 33 and the top of column 47. Notwithstanding appellant's reliance in part upon the discussion between columns 36 through 38 arguing for patentability, it is significant to note that the discussion beginning at line 36 of column 38 through at least column 42 makes clear that once an active order has been placed into the system 10 depicted in figure 1, the execution process itself is complete. Figure 18 depicts messages between the counterparts with the emphases being that "this [once an active order has been placed in the system] is the first point in the transaction that counterparties are identified to one another" as expressed at lines 40 through 42.

This last analysis leads into the discussion that the examiner begins

with in the responsive arguments in the answer at the bottom of page 6.

Because we agree with the examiner's views expressed here and the context

of the claims as viewed by the examiner as set forth here initially through

the motivation analysis, we reproduce here a good part of the responsive

arguments of the answer (pages 6 through 9) which also address appellant's

combinability arguments between Kraft and May set forth between pages 5

and 7 of the brief:

> Claims 1, 12 and 17 recite the limitation to "forward the agent to a network host, unknown to and dissimilar from the network client." Claims 25 and 26 recite the limitation "a network client and network host maintained anonymous from each other *for* receiving a payload from the network client." No other limitations regarding the anonymity of the network devices is given in any of the claims. The examiner interprets these items, then, to mean anonymity between the client and host from the time that the network server forwards the agent and/or payload, to the time that the host receives the transmission. To fulfill the limitation, one need not show maintaining of anonymity at any time after the reception of the payload, and particularly not during any time of the process execution associated with the agent. Further, one need not show anonymity between the server and the host or between the server and the client. (Final action, Para. 9).

> In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "anonymity is maintained between a client and a host (P. 4, lines 20-23)") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the

claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As shown above, maintenance of anonymity is only taught for the period of payload transmission and reception, and the anonymity may be dropped after this. Thus, the applicant's statement regarding May's eventual ending of anonymity (P. 5, lines 20-31) does not apply in regards to the claims as drawn, as this activity clearly occurs at the end of the process execution associated with the transmitted agent.

The applicant further admits that May teaches an automated system for distributing anonymous price and position information (P. 7, lines 9-12). This example further shows that the anonymity is maintained at the point of transmission.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the applicant argues that anonymity would be undesirable to Kraft (P. 6, lines 23-28) on the grounds that Kraft teaches that options include requiring digital signatures or authentication (P. 6, lines 28-34). First, these are only sample embodiments and do not by themselves preclude a Kraft combination involving anonymity. In fact, there are clearly embodiments upon which anonymity is not required (Fig. 5). Second, the authentication processes would occur at Kraft's server (#102), thus potentially maintaining anonymity between the client (remote computer) and performing host (#106). Third, such certifications occur after reception of the imported task, and thus do not preclude anonymity before or during reception of the imported task. Assuming argumendo [sic arguendo] that May teaches authentication at the end of the task, as the applicant claims (P. 7, lines 4-7), the combination would not destroy the primary invention, and therefore the combination may be allowed, given proper motivation.

May's purpose is to allow transactions between initially anonymous parties while still providing a way for them to negotiate with the same power and security as initially non-anonymous parties (col. 2, lines 1-50). As shown above, Kraft teaches an interest in developing security trades with a remote client that may be initially anonymous. May teaches that the reasons for anonymity are numerous, but include the fact that without anonymity, certain parties may not wish to deal with certain other parties (col. 2, lines 50-56), and may even cancel the transaction before it is completed, indicating a desire to ensure the maintenance of anonymity for some time, or manipulate the price based on the party identity (col. 43, lines 43-50). Thus, at the time the invention was made, one of ordinary skill in the art would have added May's anonymity handling to Kraft in order to provide remote clients with assurance of non-preferential treatment based on identity, while still allowing Kraft [sic Kraft's] servers to keep their security measures.

Thus, as argued by the examiner to the extent claimed, the entire dialog between the client and the server and the host (to the extent these elements are recited at all in any claim on appeal) is not required to be anonymous. The examiner has identified compelling portions of Kraft and May supporting the examiner's reasoning of combinability and enhancement of the security capabilities already taught in Kraft with those set forth in May. Essentially, May identifies an additional type of security consideration, that is, the identities of the actual counterparties or sending and receiving parties between a client and a host, to add to the types
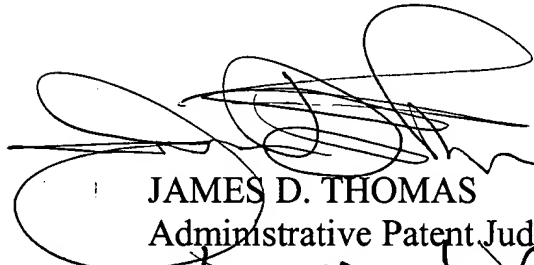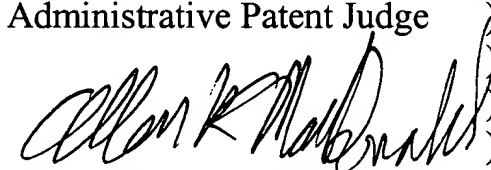
of security measures discussed beginning at column 10, line 5 in Kraft. In other words, the anonymity in the claims is not recited to be absolute or otherwise always in effect. No reply brief has been filed for our consideration challenging the examiner's views here with respect to the matters discussed in the quoted portion from the answer.

Lastly, as to the second stated rejection relying additionally upon Ellis as to certain dependent claims, the examiner's answer at page 9 has persuasively addressed each of the positions set forth with respect to argued dependent claims 13 and 18, 14 and 19, and 15 and 20, argued at pages 8 through 10 of the brief. Additionally, it is worthy of note here that appellant has not argued that the additional reference to Ellis was not properly combinable within 35 U.S.C. § 103 to the teachings already combined with respect to Kraft and May. Appellant's basic argument as to the second stated rejection then is that what is claimed is not taught by Ellis or the combined teachings of the three references. Appellant has not persuaded us of any error of the examiner's position.

In view of the foregoing, the decision of the examiner rejecting all

claims on appeal under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with

this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JAMES D. THOMAS)
Administrative Patent Judge)
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) BOARD OF PATENT
KENNETH W. HAIRSTON) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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ALLEN R. MACDONALD)
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